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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,027	01/23/2002	Thomas A. Kraker	SMD-125	7502

7590

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EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 03/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,027

Applicant(s)

KRAKER, THOMAS A.

Examiner

Dionne A. Walls

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 25-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 11 and 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to smoking article/paper wrapper, classified in class 131, subclass 365.
 - II. Claims 25-39, drawn to a process for producing a paper, classified in class 162, subclass 139.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process, such as one wherein the film-forming material is contained in a solution with a solids content of less than 3% by weight.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Mr. Tim Cassidy on February 25th, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 4-9, 10, 12-13, 15-16, 18-22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson et al (US. Pat. No. 5,878,753).

8. Peterson discloses all that is recited in the claims (col. 3, lines 15-17; col. 4, lines 51-59; see examples. Note: the claim language regarding the film-forming composition being *applied* comprising a film-forming material contained in solution, having a certain solids content and viscosity, appear to part of process limitations as they recite what occurs/values attained during a stage of the production of the final cigarette wrapper product. The instant claims are product claims, but they are limited by and defined by parameters occurring during the making of the product. The product of Petersen et al appears to be substantially the same as the product recited in the claims, i.e. a cigarette wrapper with discrete areas treated with a film-forming composition. The method by

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which this film-forming composition is formed does not patentably distinguish the claims from the prior art. Further, according to MPEP 2113, absent some evidence to the contrary, the fact that the film-forming material solution had a solids content in the claimed amounts has no patentable bearing on the end product since this value is relevant to the process conditions regarding the solution and *not* the final paper product. Applicant has not provided evidence of an *unobvious* difference between the paper of Peterson et al and that of the claimed invention. The issue is whether the claimed cigarette paper exhibits any unexpected properties as a result of the claimed solids content/viscosity as compared to the cigarette paper of Peterson et al. Since both cigarette papers appear to be similar, if not identical, Applicant must provide a comparison.)

Regarding claim 9, while Peterson et al may not specifically state that the treated areas of the cigarette wrapper of its invention have a BMI of from about 1 cm^{-1} to about 5 cm^{-1} . Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

9. Claims 1-7, 9-10, 12-13, 15-20, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hotaling et al (US. Pat. No. 5,820,998).

Hotaling et al discloses all that is recited in the claims (see entire document).

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al (US. Pat. No. 5,878,753) in view of Hotaling et al (US. Pat. No. 5,820,998).

While Peterson et al may not teach using sodium alginate, specifically, as the film-forming composition, Hotaling shows that sodium alginate, applied in bands to a cigarette paper, can be utilized as a film-forming composition to reduce the permeability on those banded areas (see abstract; col. 2, line 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to apply, to the cigarette paper of Peterson et al, sodium alginate, as a film-forming composition, in order to reduce the ability of a cigarette to ignite a combustible material, and to promote the self-extinguishing of a cigarette after burning undisturbed for a certain period of time, as taught in Hotaling et al (see col. 1, lines 12-18).

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al (US. Pat. No. 5,878,753) in view of Cohn (US. Pat. No. 4,453,553).

While Peterson et al may not articulate adding citrate to the treated areas, Cohn discloses a cigarette paper, treated with bands, which can include magnesium citrate – in addition to at least one other film-forming substance (see col. 2). It would have been

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obvious to one having ordinary skill in the art at the time of the invention to add the citrate to the treated areas of Peterson et al in order to lower the burn-rate, as taught in Cohn (see col. 2, lines 43-45).

Allowable Subject Matter

13. Claims 11 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

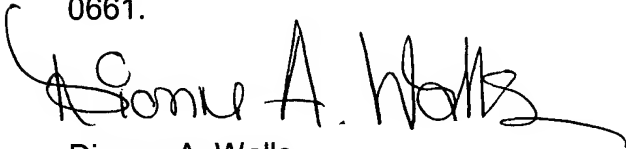
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-

0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls". The signature is written in a cursive, flowing style with a large initial "D" and a long, sweeping underline.

Dionne A. Walls
March 10, 2003